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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,440	03/25/2005	Kenji Yoshida	052340	2202
38834 7590 11/12/2009 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER HESS, DANIEL A				
ART UNIT 2876		PAPER NUMBER		
NOTIFICATION DATE 11/12/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Office Action Summary

Application No.

10/529,440

Applicant(s)

YOSHIDA, KENJI

Examiner

DANIEL A. HESS

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 12-34 and 47-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 50 and 51 is/are allowed.
- 6) ☒ Claim(s) 1-5, 12-34 and 47-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/25/05, 5/12/06, 7/24/06, 3/12/07, 9/22/08, 10/31/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to applicant's filing of response to election/restriction requirement of 8/31/2009.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 34 recites the limitation "the portable phone" in line 2. There is insufficient antecedent basis for this limitation in the claim because claim 22 upon which claim 34 depends does not have a portable phone.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 12-18, 20, 22, 23, 29 and 47-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagasaki et al. (EP 0670555). This document was cited in a PCT report related to the present application as an 'X' reference and was included in the applicant's information disclosure.

Re claims 1, 2 and 5: Attention is drawn to the entire document of Nagasaki et al., and particular attention is paid to the abstract, which summarizes the limitations of claim 1.

Attention can also be paid to the first three figures and columns 12 and 13.

Media, including audio, is encoded as a dot pattern that can then be extracted using a reader device that may be a pen device that operates in the manner claimed.

Re claim 3: See figure 2a and other figures, where the encoding can be in corresponding relation to images on a page.

Re claim 4: See figure 75 and columns 74 and 75 of Nagasaki et al. Dots are formed on a seal portion that can be attached to the surface.

Re claim 12: See discussion above. Also note figures 2a and 2b. There is a scanning pen and output, namely audio into the user's earphones.

Re claim 13: See discussion above. As the entire disclosure starting with the abstract of Nagasaki makes clear, there is a camera portion that captures the dot portion. It is indeed a program, namely a programming of the audio content into code.

Re claim 14: As figure 74 shows, a dot code sheet is superimposed on a sheet containing the corresponding image or text.

Re claim 15: The dot pattern in Nagasaki corresponds to the text that it is physically adjacent to.

Re claim 16: A machine code is in essence binary, computers at the foundation operate in binary. Thus a code will be converted to a binary string which is in essence a number.

Re claim 17: In Nagasaki, the dot pattern is produced on a flat surface of printed material.

Re claims 18, 20: See all of column 71 of Nagasaki. Infrared dots and infrared reading of the dots is discussed in depth. As to claim 20, infrared ink is typically transparent in the visible range.

Re claim 22: See discussion re claim 1, above.

Re claim 23: See discussion re claim 18, above.

Re claim 29: See column 12, lines 42-44 for instance in Nagasaki et al. Audio and voice data can be first input in correspondence with codes via a microphone.

Re claim 47: See discussion re claim 1, and note throughout Nagasaki et al. that the reader is in the form of a pen-type device.

Re claim 48: See discussion re claim 29, above.

Re claim 49: It goes without saying that an encoding scheme involves encoding rules.

As for 'various kinds of multimedia information' there are broad ways to interpret this. Different sounds for instance, as Nagasaki naturally has, can meet the limitation of 'various kinds of multimedia information.'

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 19, 21, 24-28 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasaki et al. as applied to claim 1 above.

Re claims 19, 24: Nagasaki et al. does not explicitly recite that the ink in the dots is a carbon ink. However it is typical for inks that are black to derive their black color from carbon. A motive for carbon inks is simply the black color which makes machine reading easier.

Re claim 21: Nagasaki et al. teaches, as discussed above, infrared inks as a way to have encoding that is hidden. Ultraviolet responsive inks and ultraviolet reading is an equivalent in the art to infrared for the sake of achieving invisible machine reading.

Re claims 25 and 26: Nagasaki et al. has a camera but is not explicit about what kind. C-MOS cameras and CCDs are both common in the art and are available off-the-shelf at relatively low cost. These are obviousness motivations for either CCDs or C-MOS cameras.

Re claim 27: The language that the camera unit is 'separated from' other elements is open to wide interpretation. The claim does not recite that the camera is in a separate housing or that there is any particular distance of separation. Certainly, the camera will typically be at least a separate module within a housing, as it is in Nagasaki et al.

Re claim 28: Again, the language 'separated from' is open to wide interpretation. See discussion re claim 27 above.

Re claims 30, 31: Many devices, including cameras, use internal cards in communications. Card is understood broadly. For instance, a motherboard is a card; a wireless network card is as well. A circuit board for a wired interface such as USB is also a card. See also figures 79-89 of Nagasaki et al. There is interaction with a server system.

Re claims 32 and 33: While Nagasaki is silent on the input / output device having a GPS or a portable phone, the examiner takes the view that both of these are functionally unimportant for the sake of the essentially operation of a decoding device. Global positioning has little to do with code conversion to voice and neither does a portable phone. GPS systems and portable phones are ubiquitous now among computing devices, and they can happen to be coincidentally present.

Allowable Subject Matter

Claims 50-51 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach or fairly suggest a computer executable program for registering a paper icon which has a dot pattern portion formed on a medium and code information associated with the paper icon by using a scanner connected to an information processing device, having all of the steps recited.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL A. HESS whose telephone number is (571)272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel A Hess/
Primary Examiner, Art Unit 2876